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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,981	10/01/2003	Jean Tricoit	8881/89340 CIP	7686

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EXAMINER	
PEARSE, ADEPEJU OMOLOLA	
ART UNIT	**PAPER NUMBER**
1761	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/676,981	TRICOIT ET AL.	
	Examiner	Art Unit	
	Adepeju Pearse	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The disclosure contains words missing letters throughout entire specification. For example, page 1 line32 contains the word "phnolic" instead of --phenolic--. Applicant is advised to review the content of the specification to correct these errors.

Appropriate correction is required.

Claim Objections

1. Claims 1-10 are objected to because of the following informalities: The claim recites a "method comprises the step consisting of". It is unclear as to what it is intended to limit. See claims 4 and 9. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bunker (U.S. Pat. No. 6,197,358 B1) in view of Cherry et al (U.S. Pat. No. 4,937,085), Shoji (U.S. Pat. No. 6,855,352) and applicant's own prior art admission. With regard to claims 1-2 and 4, Bunker discloses a process for making dehydrated potato products comprising the steps of washing, peeling, and slicing raw potatoes to form potato pieces and then dried using a drying apparatus to form potato sheets which are then comminuted to form potato flakes. The potato pieces are then precooked using steam and vacuum cooled to form a potato mash (Abstract). He also discloses adding additives to the potato mash such as antioxidants (Col 1, lines 48-53).
Also see figures 1 and 3. However, Bunker does not show adding chlorogenic acid. Applicant admits on page 2 line 3 of the specification that chlorogenic acid is a potent antioxidant in the food industry. Since Bunker discloses the use of antioxidants in a cooked potato product, it would be obvious to one of ordinary skill in the art to utilize antioxidants including chlorogenic acid to prevent after cooking oxidation of the food product.

2. With regard to claims 3 and 6, Bunker teaches adding emulsifiers to potato mash (col 3 line 37). Bunker is silent as to the type of emulsifier, however, lecithin is a well-known emulsifier in the art and it would be obvious to one of ordinary skill in the art to utilize lecithin or any other suitable emulsifier in the product.

3. With regard to claims 5 and 10, Bunker failed to disclose the amounts of the emulsifier and chlorogenic acid. However, it would be obvious to one of ordinary skill in the art to utilize effective amounts of these ingredients in order to inhibit the browning of the food product.

4. With regard to claim 7, Bunker failed to disclose obtaining chlorogenic acid from Potatoes. However, Cherry et al teaches that chlorogenic acid is present in potatoes naturally (Col 1 lines 48-50). It would have been obvious to one of ordinary skill in the art to modify Bunker with Cherry et al because the polyphenol, in this case chlorogenic acid, can be produced economically and efficiently and it would be expected that the potato would be disintegrated either by cutting or some other form in order to obtain the acid.

5. With regard to claim 8, this is a product by process limitation. Bunker teaches a dehydrated potato product washing, peeling, and slicing raw potatoes to form potato pieces and then dried using a drying apparatus to form potato sheets, which are then comminuted to form potato flakes.

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

6. With regard to claim 9, Bunker failed to disclose adsorbing chlorogenic acid from potatoes. However, Shoji teaches obtaining a polyphenol such as chlorogenic acid from fruit (abstract) by treating the juice or extract with an adsorbent and a fraction adsorbed to the adsorbent contains a polyphenol. The adsorbed fraction is eluted with alcohol so as to obtain the polyphenol fraction (col 2 lines 1-5). Shoji is silent as to obtaining chlorogenic acid from potatoes. However, it is well known in the art that chlorogenic acid is naturally present in potatoes. It would be obvious to one of ordinary skill in the art to modify Bunker with Shoji by obtaining chlorogenic acid from the potatoes because it is more economical and efficient.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art discloses applicable subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adepeju Pearse whose telephone number is 571-272-8560. The examiner can normally be reached on Monday through Friday, 8.00am - 4.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peju Pearse
Art Unit 1761

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